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703-308-9797
703-305-0942 (fax)

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

SYNGENTA PARTICIPATIONS AG
(09/032,086),
Junior Party,

v.

BAYER CROPSCIENCE GmbH
and BAYER BIOSCIENCE N.V.
(09/147,993),
Senior Party.

Interference No. 105,041

Before LEE, **TORCZON**, and SPIEGEL, Administrative Patent Judges.

DECISION ON MOTIONS and JUDGMENT
(PURSUANT TO 37 CFR §§ 1.640 and 1.662(a))

INTRODUCTION

The parties have moved jointly to have certain Syngenta claims designated as not corresponding to the count (Paper 20). Contingent on the grant of that motion, Syngenta has requested adverse judgment under 37 C.F.R. § 1.662(a) (Paper 22). The motion is granted and consequently judgment is entered.

FACT FINDINGS

[1] The parties would like claims 43-51, 56, 94-102, and 107 of the Syngenta application to be redesignated as not corresponding to the count (Paper 20 at 2).

[2] Count 1, the sole count, is:

> The method of Syngenta claim 93 OR the process of Hoechst claim 7.

[3] Syngenta claim 93 is:

> A method for producing a conditional female sterile monocotyledonous plant comprising:
>
> (a) introducing into a monocotyledonous plant cell an expression cassette according to claim 57; [and]
>
> (b) obtaining a conditional female sterile monocotyledonous plant from said monocotyledonous plant cell of step (a).

[4] Syngenta claim 57 is:

> An expression cassette comprising a female-preferential promoter capable of female-preferential activity in a monocotyledonous plant operably linked to a coding sequence of interest, wherein said coding sequence of interest encodes an enzyme which catalyzes the conversion of N-acetyl-phosphinothricin to phosphinothricin and wherein said coding sequence is obtained from an argE gene.

[5] Bayer claim 7 is:

> [A p]rocess for producing transgenic plants containing selectively destructible plant parts, wherein an N-Ac-PTC or N-Ac-PTT deacetylase gene is placed under the control of a pistil- or stigma[-]specific promoter, and the pistil[] or stigma are caused to die by means of suitable, timely treatment with N-acetyl-PTC or N-acetyl-PTT.

[6] The claims to be redesignated all depend from either Syngenta claim 43 or Syngenta claim 94, both of which require "interplanting".

[7] Syngenta claim 43 is (emphasis added):

> A method for hybrid seed production comprising:
>
> (a) obtaining a conditional female sterile monocotyledonous plant comprising a female-preferential promoter capable of female-preferential activity

in a monocotyledonous plant operably linked to a coding sequence which encodes an enzyme which catalyzes the conversion of N-acetyl-phosphinothricin to phosphinothricin, wherein said coding sequence is obtained from an argE gene;

(b) interplanting the conditional female sterile plant with a male sterile plant;

(c) inducing female sterility by applying N-acetyl-phosphinothricin to the conditional female sterile plant; and

(d) producing monocotyledonous hybrid seed.

[8] Syngenta claim 94 is (emphasis added):

A method for hybrid seed production comprising:

(a) obtaining a conditional female sterile monocotyledonous plant comprising a female-preferential promoter capable of female-preferential activity in a monocotyledonous plant operably linked to a coding sequence which encodes an argE enzyme which catalyzes the conversion of N-acetyl-phosphinothricin to phosphinothricin;

(b) interplanting the conditional female sterile plant with a male sterile plant;

(c) inducing female sterility by applying N-acetyl-phosphinothricin to the conditional female sterile plant; and

(d) producing monocotyledonous hybrid seed.

[9] Bayer has not presented comparable interplanting claims.

[10] The first named inventor of Syngenta's application is "Harper".

[11] Syngenta defines "interplanting" in the specification (p. 4, ¶3) as follows:

Rather than being in separate blocks of rows so that seed from only the female parent plants can be harvested, the male and female parent plants need to be interplanted in the same rows meaning that the plants are centimeters, rather than meters[,] apart.

[12] The specification (p.4, ¶2) lists disadvantages that attend not being able to interplant.

[13] Syngenta has submitted the declaration of Earl A. Wernsman.[1]

[14] Dr. Wernsman states that he reviewed the Bayer and Syngenta claims and disclosed art. Based on that review, Dr. Wernsman declared that the non-interplanting claims do not anticipate the interplanting claims and do not teach or suggest the interplanting claims.

[15] Dr. Wernsman provided a detailed explanation of how he reached his conclusion.

[16] Dr. Wernsman provided further reasons why one skilled in the art at the time of filing would not have been motivate to interplant crops according to the invention.

[17] The declaration of Dr. Wernsman appears to be credible on its face.

[18] The examiner of the Syngenta application, David Fox, reviewed the Wernsman declaration (37 C.F.R. § 1.614(c)) and concluded:

> I have reviewed the declaration you faxed me, as well as the Harper specification (U.S. Patent 6,392,123) and the claims of each party (I kept a copy of all claims involved in the interference). Given the statements provided by the declarant, who is clearly an expert in the field, and is not directly affiliated with either interfering party, I agree that Harper's definition of "interplanting", and the use of such interplanting of conditionally female sterile plants with male sterile plants in a method of hybrid seed production, would not have been obvious to the artisan of ordinary skill. I conclude that the "interplanting claims" of Harper would not have been obvious over the "non-interplanting claims" of each party. My statements below regarding alternate uses of conditionally female-sterile plants, such as the production of seedless fruits, may be used as additional evidence that Harper's "interplanting"/hybrid production/process-of-using claims are not obvious over each party's product claims (conditionally female sterile plants) or each party's claims drawn to a process of making the products.

[19] The "statements below" from the examiner further noted:

> [T]here are other uses of conditionally female sterile plants, such as means of making seedless fruit when conditionally sterile, then using the plants to reproduce seed for propagation, possibly by self-fertilization rather than

[1] None of the exhibits were properly marked.

> cross-pollination (hybridization) when conditionally female fertile. There are some fruit plants which are monocotyledonous, such as banana, pineapple and I believe cassava and/or mango. There are other issued patents which are drawn to this concept, including Oliver et al, 5,723,765, column 6, lines 30-35. (Oliver uses a different coding sequence, and also employs genes encoding site-specific recombinases). Another use of female sterility that I can think of is the production of flowers which do not set seed in ornamental crops, so that all of the plant's energy can be devoted to producing flowers, and so that flowering will continue throughout the season (as opposed to having flowering stop after seed-filled fruit are formed). The Harper specification (6392123) does not appear to have literal basis for alternate uses of the plant, but they are art-recognized.

[20] The opinion of David Fox, a primary examiner in the relevant art, is reasonable and greatly appreciated.

DISCUSSION

As a consequence of this decision, Syngenta will not be entitled to claims drawn to the same invention as the subject matter of the count. 35 U.S.C. 135(a). Similarly, Syngenta would not be entitled to obvious variants of the subject matter of the count. In re Deckler, 977 F.2d 1449, 1452, 24 USPQ2d 1448, 1449 (Fed. Cir. 1992). In view of the evidence from Dr. Wernsman and the opinion of the examiner, we determine that the Syngenta interplanting claims are patentably distinct from the subject matter of the count. In view of this determination it is appropriate to redesignate claims 43-51, 56, 94-102, and 107 of the Syngenta application as not corresponding to the count. The joint motion is GRANTED.

The joint motion having been granted, the contingency for Syngenta's request for adverse judgment is met.

ORDER

Upon consideration of the joint motion and the request for adverse judgment, it is:

ORDERED that claims 43-51, 56, 94-102, and 107 of the Syngenta application be redesignated as not corresponding to Count 1;

FURTHER ORDERED that judgment on priority as to Count 1 is awarded against junior party Syngenta Participations AG;

FURTHER ORDERED that Syngenta is not entitled to a patent containing claims 57-59, 69-71, 81-83, 93, 108-110, 114-116, 120-122, and 126 of the Syngenta 086 application, which correspond to Count 1;

FURTHER ORDERED that, based on the record before us, Bayer CropScience GmbH is entitled to a patent containing claims that correspond to Count 1;

FURTHER ORDERED that a copy of the Wernsman declaration be entered into the Syngenta 086 application; and

FURTHER ORDERED that a copy of this decision be given a paper number and be entered in the administrative records of Syngenta's 086 application and Bayer's 993 application.

JAMESON LEE
Administrative Patent Judge

RICHARD TORCZON
Administrative Patent Judge

CAROL A. SPIEGEL
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

INTERFERENCE TRIAL SECTION

Entered: 7 May 2003

Notice: Any agreement or understanding between parties to this interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the United States Patent and Trademark Office before termination of the interference as between said parties to the agreement or understanding. 35 U.S.C. 135(c); 37 C.F.R. § 1.661.

cc (electronic mail):

Counsel for Syngenta Participations AG (Bayer CropScience also has an interest):

Dimitrios T. Drivas
Scott T. Weingaertner
John Scheibeler
WHITE & CASE LLP
1155 AVE OF THE AMERICAS
NEW YORK NY 11036
Tel: 212-819-8200
Fax: 212-354-8113

Counsel for Bayer CropScience GmbH and Bayer BioScience N.V. (Syngenta also has an interest):

William F. Lawrence
Thomas J. Kowalski
FROMMER LAWRENCE & HAUG
745 5TH AVE
NEW YORK NY 10151
Tel: 212-588-0800
Fax: 212-588-0500